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OFFICE OF PETITIONS

In re Application of	:	
Shui-on Leung and Hans Hansen	:	DECISION ON RENWEED
Application No. 09/988,013	:	PETITION PURSUANT TO
Filed: November 16, 2001	:	37 C.F.R. § 1.183
Attorney Docket No. IMMU-	:	
0014US2	:	
Title: IMMUNOCONJUGATES AND	:	
HUMANIZED ANTIBODIES SPECIFIC	:	
FOR B-CELL LYMPHOMA AND	:	
LEUKEMIA CELLS	:	

This is in response to the renewed petition filed pursuant to 37 C.F.R. § 1.183 on October 19, 2011, seeking the waiver of the requirement present in 37 C.F.R. § 1.131 that each of the inventors sign the declaration of prior inventorship.

This renewed petition pursuant to 37 C.F.R. § 1.183 is
DISMISSED.

BACKGROUND

The above-identified application was filed on November 16, 2001. On April 30, 2002, a 37 C.F.R. § 1.63 declaration signed by each joint inventor was submitted to the Office. On August 30, 2010, Petitioner submitted both a declaration pursuant to 37 C.F.R. § 1.131 that has been executed by the second-named inventor and an original petition pursuant to 37 C.F.R. § 1.183, seeking the waiver of the requirement present in 37 C.F.R. § 1.131 that the first-named inventor sign the declaration of prior inventorship.

The original petition pursuant to 37 C.F.R. § 1.183 was dismissed via the mailing of a decision on December 13, 2010.

It is noted that on January 4, 2011, a non-final Office action was mailed which discusses this issue on pages three and four of the same.

Petitioner has filed this renewed petition, seeking the acceptance of the Rule 1.131 declaration without the signature of inventor Leung. Petitioner has indicated that the signature of inventor Leung cannot be obtained as he cannot be located.¹

RELEVANT REGULATIONS AND PORTION OF THE MPEP

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.131(a) sets forth, *in pertinent part*:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

ANALYSIS

Here, there has not been a party qualified under 37 C.F.R. §§ 1.42, 1.43, or 1.47. In addition, Petitioner does not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the revised Rule 1.131 declaration include all of the joint inventors.

This renewed petition cannot be granted, as although Petitioner has asserted the existence of an extraordinary situation such that justice requires the waiver of the requirement that the Rule 1.131 declaration be executed by

¹ See renewed petition, pages three and four and concurrently submitted declaration of Ms. McDowell, page 2.

each joint inventor, this assertion has not been established. A discussion follows.

While Rule 1.47(a) is not directly applicable to the current set of facts, it does provide an analogous analysis as to the required showing to rectify situations involving a joint inventor who cannot be located to execute a declaration. As such, a Rule 1.47(a) analysis will be applied to determine whether an extraordinary situation is present, such that justice requires the waiver of the rules in this situation. The applicable elements are as follows:

- (1) Petitioner must provide a statement of the last known address of each non-signing inventor;
- (2) Petitioner must provide either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to each non-signing inventor for review and proof that each non-signing inventor refuses to join in the application or
 - b) proof that each non-signing inventor cannot be found or reached after diligent effort.

Petitioner has satisfied the first requirement above. The second requirement has not been satisfied.

Petitioner has asserted that a package was sent to the last known address of the non-signing inventor, and that she was informed "by Federal Express that Dr. Leung had moved..."² Petitioner then sent a second package to that same address using a different mail carrier, in the hopes that the second mail carrier would have a forwarding address for the non-signing inventor, however this second mailing was returned to Petitioner with the notation "addressee unknown."³

It follows that subsequent to the mailing of the decision on the original petition, Petitioner learned that the last known address is no longer valid. Consequently, with this renewed

2 Petition, page three. See also concurrently submitted declaration of Ms. McDowell, page two and Appendix A which contains a copy of a FedEx delivery label with the notation "moved" written thereon.

3 Petition, page four. See also concurrently submitted declaration of Ms. McDowell, page two and Appendix B which contains a copy of a USPS delivery label with the notation "Address unknown" placed thereon.

petition, Petitioner has asserted that the non-signing inventor cannot be located. However, as *Petitioner has set forth that the non-signing joint inventor cannot be located, Petitioner is required to establish that a diligent effort was made to locate the non-signing inventor, and the petition is silent as to any search that might have been performed for Mr. Leung:* the sending of a package in the hopes that the addressee has left a forwarding address with the mail carrier does not rise to the level of constituting a search. There is no indication that Petitioner attempted to verify the address of the non-signing inventor or to determine her forwarding address, and to send the complete application papers to that address for consideration by the inventor, other than the aforementioned mailing of the second package. Petitioner must provide a showing detailing the attempts that were made to obtain a forwarding address or to locate the non-signing inventor by means such as through E-mail, telephone, and the Internet. If this search is sufficiently broad so as to provide a reasonable opportunity to locate this individual, and it is then averred that such attempts failed, then Petitioner will have provided the necessary proof that the non-signing inventor cannot be reached. Details of the efforts to locate the non-signing inventor are to be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Prior to filing a second renewed petition, Petitioner must attempt to locate the non-signing inventor.

If Petitioner is able to secure the signature of this individual on the Rule 1.131 declaration, the submission of the same would be considered fully responsive to this decision.

If Petitioner is not able to secure the signature of this individual on the Rule 1.131 declaration, Petitioner must then indicate the steps taken to obtain this individual's signature on the Rule 1.131 declaration.

CONCLUSION

The time period for filing a second renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.183." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any subsequent filing pertaining to this matter should indicate that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,⁴ hand-delivery,⁵ or facsimile.⁶ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.⁷

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

The general phone number for the Office of Petitions that should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.⁸ All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski
Senior Attorney
Office of Petitions

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

6 (571) 273-8300: please note this is a central facsimile number.

7 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

8 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).